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EXAMINER	
GERGISO, TECHANE	

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,593	GOLDMAN, OLIVER	
	Examiner	Art Unit	
	Techane J. Gergiso T.G	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-48 have been examined.

2. Claims 1-48 have been rejected.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 18, 20, 26-29, and 43 rejected under 35 U.S.C. 102(e) as being fully anticipated by Geist et al. (US Pub No.: 2005/0021474).

As per claim 1:

Geist et al. fully disclose a computer implemented method, comprising:

accessing an electronic document using a user application, the electronic document including a digital signature module (Page 10: 0140-0142); and

using the digital signature module to perform one or more digital signature operations on the electronic document in the user application (Page 8: 0119-0121).

As per claim 2:

Geist et al. fully disclose a method, wherein using the digital signature module includes:

validating the digital signature module (Page 12: 0175); and

using the digital signature module to perform digital signature operations only if the digital signature module is validated (Figure 11: 406) .

As per claim 3:

Geist et al. fully disclose a method, wherein:

using the digital signature module includes signing the electronic document (Page 4: 0045, 0058; Page 9:0134).

As per claim 4:

Geist et al. fully disclose a method, wherein:

using the digital signature. module includes authenticating a digital signature in the electronic document (Figure 9: 208, 216, 218, 209, 219).

As per claim 18:

Geist et al. fully disclose a electronic document, comprising:

electronic content (Page 6: 0082); and

a digital signature module, the digital signature module being operable upon loading to perform digital signature operations on the electronic content (Page 8: 0119-0121).

As per claim 20:

Geist et al. fully disclose a computer implemented method, comprising:

receiving a signed electronic document, the electronic document including a digital signature module and a digital signature generated by the digital signature module (Figure 8; Column 3:0045; Page 0136; Figure 9);

accessing the electronic document in a user application (Figure 8; Column 3:0045; Page 0136; Figure 9); and

validating the digital signature using the digital signature module in the user application (Figure 8; Column 3:0045; Page 0136; Figure 9).

As per claims 26-29, and 43:

Claims 26-29 and 43 are a computer program product that corresponds to their method claims 1-4 and 20 respectively. Therefore, claims 26-29 and 43 are rejected with the same rationale given to reject their corresponding method claims 1-4 and 20 respectively.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5-14, 23-25, 30-39, and 46-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Geist et al. (US Pub No.: 2005/0021474) in view of Padhye et al. (US Pub. No.: 2003/0023564).

As per claim 5:

Geist et al. do not explicitly disclose using the digital signature module includes using the digital signature module running on a server. Padhye et al. in analogous art, however, disclose using the digital signature module includes using the digital signature module running on a server (Page3: 52C; Figure 10: 740; Column 3: 0037). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Geist et al. to include using the digital signature module includes using the digital signature module running on a server. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a point of capture system adapted to generate content, the right information having secure mechanism that secures when the content when the content is generated as suggested by Padhye et al. (Page 2: 0013).

As per claim 6:

Geist et al. discloses a method, wherein:

including the digital signature module includes including a reference to the digital signature module (Page 8: 0124).

As per claim 7:

Geist et al. discloses a method, wherein using the digital signature module to perform a digital signature operation includes:

receiving a request to perform a digital signature operation (Page 5: 0067);

determining whether the requested digital signature operation is authorized (Page 5: 0067); and

if the digital signature operation is authorized, using the digital signature module to perform the requested digital signature operation (Page 7: 0098).

As per claim 8:

Padhye et al. discloses a method, wherein:

determining whether the requested digital signature operation is authorized includes determining whether the requested digital signature operation is authorized based on rights information associated with the digital signature module, the user application, or the electronic document (Page3: 52A-52C; Figure 10: 740; Column 3: 0037).

As per claim 9:

Padhye et al. discloses a method, wherein:

the rights information is operable to specify the digital signature operations that can be performed on the electronic document (Page3: 52A-52C; Figure 10: 740; Column 3: 0037).

As per claim 10:

Padhye et al. discloses a method, wherein:

the rights information is operable to specify constraints on the digital signature operations that can be performed on the electronic document (Page3: 52A-52C; Figure 10: 740; Column 3: 0037).

As per claim 11:

Geist et al. discloses a method, wherein:

using the digital signature module includes performing a digital signature operation on a portion of the electronic document or on a user added content portion of the electronic document (Page 5: 0079).

As per claim 12:

Padhye et al. discloses a method, comprising:

receiving input adding content to the electronic document in the user application, wherein using the digital signature module includes performing a digital signature operation on the added content (Figure 1: 72; Page 3: 0037; Figure 2: 44C).

As per claim 13:

Padhye et al. discloses a method, comprising:

receiving input modifying content of the electronic document in the user application, wherein using the digital signature module includes performing the digital signature operations on the modified content (Figure 1: 72; Page 3: 0037; Figure 2: 44C; Figure 3: 52C).

As per claim 14:

Geist et al. discloses a method, wherein:

the electronic document is a PDF document (Page 10: 0140-0142).

As per claim 23:

Geist et al. discloses a method, wherein:

performing the digital signature operation includes performing the digital signature operation on a portion of the electronic document (Page 5: 0079); and

transmitting the electronic document includes transmitting only the portion of the electronic document on which the digital signature operation is performed (Page 3: 0045)

As per claim 24:

Padhye et al. discloses a method a method, further comprising:

receiving input adding content to the electronic document in the user application, wherein using the digital signature module includes performing a digital signature operation on the added content (Figure 1: 72; Page 3: 0037; Figure 2: 44c).

As per claim 25:

Padhye et al. discloses a method comprising:

receiving input modifying content of the electronic document in the user application wherein using the digital signature module includes performing a digital operation on the modified content (Figure 1: 72; Page 3: 0037; Figure 2: 44C; Figure 3: 52C).

As per claims 30-39 and 46-48:

Claims 30-39 and 46-48 are a computer program product that corresponds to their method claims 5-14 and 23-25 respectively. Therefore, claims 30-39 and 46-48 are rejected with the same rationale given to reject their corresponding method claims 5-14 and 23-25 respectively.

7. Claims 15, 16, 21, 40, 41 and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Geist et al. (US Pub No.: 2005/0021474) in view of Slater et al. (US Pat. No.: 6,796,489).

As per claim 15:

Geist et al. discloses a computer implemented method, comprising:

embedding a digital signature module in an electronic document, the digital signature module being operable to perform one or more digital signature operations on the electronic document (Figure 8; Figure 9)

providing a first version of the electronic document to a recipient, the first version including the embedded digital signature module ((Page 10: 0140-0142); and

receiving a second version of the electronic document, the second version including digital signature information indicating that a digital signature operation has been performed on the electronic document using the embedded digital signature module (Page 3: 0045).

Geist et al. do not explicitly disclose embedding a digital signature module in an electronic document. Slater et al., in analogous art, however, disclose embedding a digital signature module in an electronic document (Figure 3A-3E: Page 10: lines 1-41). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Geist et al. to include embedding a digital signature module in an electronic document. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to allow an electronic documents that are digitally signed to be validated, processed and recorded at a point of capture system adapted to generate content, the right information having secure mechanism that secures the content when the content is generated as suggested by Slater et al. (Page 1: lines 9-21).

As per claim 16:

Geist et al. disclose a method, wherein:

the digital signature module is signed using a digital signature (Figure 8: 130).

As per claim 21:

Geist et al. disclose a method comprising:

performing a digital signature operation embedding digital signature information in the electronic document, the digital signature operation being performed using the digital signature module after optionally modifying the electronic document Page 3: 0045; Figure 7a; Figure 8); and

transmitting the electronic document, including the embedded digital signature module and the digital signature information (Page 3: 0045).

Geist et al. do not explicitly disclose embedding a digital signature module in an electronic document. Slater et al., in analogous art, however, disclose embedding a digital signature module in an electronic document (Figure 3A-3E: Page 10: lines 1-41). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Geist et al. to include embedding a digital signature module in an electronic document. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to allow an electronic documents that are digitally signed to be validated, processed and recorded at a point of capture system adapted to generate content, the right information

having secure mechanism that secures the content when the content is generated as suggested by Slater et al. (Page 1: lines 9-21).

As per claims 40, 41 and 44:

Claims 40, 41 and 44 are a computer program product that corresponds to their method claims 15, 16 and 21 respectively. Therefore, claims 40, 41 and 44 are rejected with the same rationale given to reject their corresponding method claims 15, 16 and 21 respectively.

8. Claims 17, 19 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geist et al. (US Pub No.: 2005/0021474) in view of Slater et al. (US Pat. No.: 6,796,489) in further view of Padhye et al. (US Pub. No.: 2003/0023564).

As per claim 17:

Geist et al. do not explicitly disclose embedding rights information in the electronic document, the rights information being operable to enable a set of rights required to perform the digital signature operations. Padhye et al. in analogous art, however, disclose rights information in the electronic document, the rights information being operable to enable a set of rights required to perform the digital signature operations (Figure 3A-3E: Page 10: lines 1-41). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Geist et al. to include embedding a digital signature module in an electronic document. This modification would have been obvious because a person

having ordinary skill in the art would have been motivated to do so to allow an electronic documents that are digitally signed to be validated, processed and recorded at a point of capture system adapted to generate content, the right information having secure mechanism that secures the content when the content is generated as suggested by Slater et al. (Page 1: lines 9-21).

As per claim 19:

Geist et al. do not explicitly disclose rights information, the rights information being operable to enable one or more operations on the electronic document, the one or more operations including using the digital signature module to sign the electronic document Padhye et al. in analogous art, however, disclose rights information (Figure 3A-3E: Page 10: lines 1-41). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Geist et al. to include rights information. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to allow an electronic documents that are digitally signed to be validated, processed and recorded at a point of capture system adapted to generate content, the right information having secure mechanism that secures the content when the content is generated as suggested by Slater et al. (Page 1: lines 9-21).

As per claim 42:

Claim 42 is a computer program product that corresponds to its method claim 17. Therefore, claim 42 is rejected with the same rationale given to reject its corresponding method claim 17.

9. Claims 22 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geist et al. (US Pub No.: 2005/0021474) in view of Hughes (US Pub. No.: 2002/0184504).

As per claim 22:

Geist et al. do not explicitly disclose receiving a signed electronic document includes receiving the signed electronic document as a user in a multi-user sequence defined by a workflow; and transmitting the electronic document includes transmitting the electronic document to another user in the workflow. Hughes, in analogous art, however, discloses a system of combining digital signature, extracting individual signature and verifying individual combined signatures (Page 3: 0029-0033; Figure 17, 18, 24). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Geist et al. to include receiving a signed electronic document includes receiving the signed electronic document as a user in a multi-user sequence defined by a workflow; and transmitting the electronic document includes transmitting the electronic document to another user in the workflow. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to guard against tree extension attack as suggested by Hughes (Page 1: lines 9-21).

As per claim 45:

Claim 45 is a computer program product that corresponds to its method claim 22. Therefore, claim 45 is rejected with the same rationale given to reject its corresponding method claim 22.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See the notice of reference cited in form PTO-892 for additional prior art

Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is (571) 273-3784. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. G

Techane Gergiso

Patent Examiner

Art Unit 2137

March 30, 2006

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER